HEWLETT-PACKARD COMPANY
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10015906-1



**IN THE**
**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Inventor(s):** Kenneth Deh-Lee

**Confirmation No.:** 4692

**Application No.:** 10/056,592

**Examiner:** L. S. Wassum

**Filing Date:** 01/23/2002

**Group Art Unit:** 2167

**Title:** DYNAMIC KNOWLEDGE EXPERT RETRIEVAL SYSTEM

**Mail Stop Appeal Brief-Patents**
**Commissioner For Patents**
**PO Box 1450**
**Alexandria, VA 22313-1450**

**TRANSMITTAL OF APPEAL BRIEF**

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on **04/04/2005**.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

**(complete (a) or (b) as applicable)**

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

| | | |
|---|---|---|
| ( ) | one month | $120.00 |
| ( ) | two months | $450.00 |
| ( ) | three months | $1020.00 |
| ( ) | four months | $1590.00 |

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of **$500.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Date of Deposit 06/03/2005

I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Director for Patents, Alexandria, VA 22313-1450.

Typed Name: Phyllis Ewing

Signature:

Respectfully submitted,

Kenneth Deh-Lee

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Fort Collins, Colorado 80527-2400

Docket No. 10015906-1
(PATENT)



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:
Kenneth Deh-Lee

Application No.: 10/056,592 | Confirmation No.: 4692

Filed: January 23, 2002 | Art Unit: 2167

For: DYNAMIC KNOWLEDGE EXPERT RETRIEVAL SYSTEM | Examiner: L. S. Wassum

# APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months after the Notice of Appeal filed in this case on April 4, 2005, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

| | |
|---|---|
| I. | Real Party In Interest |
| II | Related Appeals and Interferences |
| III. | Status of Claims |
| IV. | Status of Amendments |
| V. | Summary of Claimed Subject Matter |
| VI. | Grounds of Rejection to be Reviewed on Appeal |
| VII. | Argument |
| VIII. | Claims |
| IX. | Evidence |
| X. | Related Proceedings |

Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 23 claims, numbered 1-2 and 4-24, pending in this application.

B. Current Status of Claims

1. Claims canceled: Claim 3

2. Claims withdrawn from consideration but not canceled: None

3. Claims pending: Claims 1-2, 4-24

4. Claims allowed: None

5. Claims rejected: Claims 1-2, 4-24

C. Claims On Appeal

The claims on appeal are claims 1-2, 4-24

## IV. STATUS OF AMENDMENTS

Appellant filed an Amendment After Final Rejection on March 4, 2005 in response to a Final Office Action, mailed January 4, 2005, rejecting all of the pending claims. The paper filed on March 4 amended claim 1 to include limitations of claim 3, which depended from claim 1 and was cancelled. The Examiner responded to the Amendment After Final Rejection in an Advisory Action mailed March 24, 2005. In the Advisory Action, the Examiner indicated that Appellant's proposed amendments to claim 1 would be entered. Accordingly, the claims enclosed herein as Appendix A incorporate the amendments to claim 1 as indicated in the Amendment After Final Rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter relates to a method for identifying relevant experts using a search request from a user. According to claim 1, the method comprises the steps of maintaining an updateable and searchable database of expert profiles ([0007], lines 2-3; [0009] line 1) wherein the profiles include attributes of a particular expert ([0012], lines 5-9; 110, Figure 1), and wherein one of the attributes is the expert's real-time availability ([0016], lines 2-7). The method also includes receiving a search request from a user ([0019], lines 2-3) and applying a weight designated by the user to the attributes of a desired expert ([0020], lines 1-2; [0037], lines 2-3).

According to claim 2, the method further includes searching a database using the search request ([0019], lines 2-6) and displaying a list of ranked experts ([0025], lines 1-4; [0026], lines 1-4), wherein each expert's position in the ranked list is determined by a ranking algorithm ([0007], line 6; [0019], line 9) wherein said ranking algorithm uses the weights of each attribute and is based on both static and dynamic attributes ([0020], lines 4-7; [0023], lines 6-7).

According to claim 4, the database automatically updates the expert's availability ([0028], lines 7-9; [0035], lines 4-6). According to claim 6, the attribute is the expert's available time until a next assignment ([0013], lines 1-7). According to claim 9, the attribute is the expert's available contact method ([0026], lines 2-3; [0027], lines 1-2).

The claimed subject matter also includes a system for searching for experts. According to claim 17, the system comprises a searchable and updateable database of expert information ([0007], lines 2-3), wherein said database comprises a plurality of expert profiles ([0012], lines 2-3; [0016], lines 1-2), each of said profiles including data relating to one or more static and dynamic attributes of a particular expert ([0023], lines 6-7; [0032], lines 3-6). The system also includes a user interface for allowing users to identify desired characteristics of a desired expert ([0023], lines 1-5; [0025], lines 1-2; [0026], lines 2-4), wherein the user interface also allows users to assign weights to one or more of the desired characteristics ([0007], lines 4-5). The system further includes a processor for searching said database using said desired characteristics ([0007], lines 2-4) and generating a list of ranked experts ([0007],

lines 4-5; [0008], lines 1-2). Finally, the system includes a display for displaying said ranked list ([0026], lines 1-2), wherein each expert's position in the list is determined by a ranking algorithm based on said static attributes and said dynamic attributes ([0020] lines 4-7; [0023], lines 5-7).

## VI. GROUNDS OF OBJECTION TO BE REVIEWED ON APPEAL

### A. First Ground for Rejection

Whether claims 1, 5, 7, 8, 15, and 16 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,862,223 to Walker et al. (hereinafter "Walker") in view of U.S. Patent Number 6,325,632 to Chao et al. (hereinafter "Chao").

### B. Second Ground for Rejection

Whether claims 4, 6, and 9 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,862,223 to Walker et al. (hereinafter "Walker") in view of U.S. Patent Number 6,325,632 to Chao et al. (hereinafter "Chao").

### C. Third Ground for Rejection

Whether claims 17, 20 and 21 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao and further in view of U.S. Patent Number 5,544,049 to Henderson et al. (hereinafter "Henderson").

### D. Fourth Ground for Rejection

Whether claim 2 properly stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, and further in view of Henderson.

### E. Fifth Ground for Rejection

Whether claim 10 properly stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of keen.com.

F. Sixth Ground for Rejection

Whether claims 11-14 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of U.S. Patent Number 6,223,165 to Lauffer (hereinafter "Lauffer").

G. Seventh Ground for Rejection

Whether claims 18, 19, 22 and 23 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of U.S. Patent Number 6,370,231 to Hice (hereinafter "Hice").

H. Eighth Ground for Rejection

Whether claim 24 properly stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao in view of Henderson in view of Hice and further in view of U.S. Patent Number 5,570,100 to Grube et al. (hereinafter "Grube").

## VII. ARGUMENT

### A. Claims 1, 5, 7, 8, 15, and 16

Claims 1, 5, 7, 8, 15, and 16 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,862,223 to Walker et al. (hereinafter "Walker") in view of U.S. Patent Number 6,325,632 to Chao et al. (hereinafter "Chao").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the first or second criteria, Appellant asserts that the rejection does not satisfy the third criteria.

Claim 1 requires maintaining an updateable and searchable database of expert profiles, wherein the profiles include attributes of a particular expert, and wherein one of the attributes is the expert's real-time availability. The combination of Walker and Chao fails to disclose maintaining ... the expert's real-time availability. Walker is an on-line exchange for matching user requests with an appropriate expert. (Walker, col. 7, lines 6-14). As part of the exchange, a user sends a request which is routed to appropriate experts, who can then bid on the job. (Walker, col. 7, lines 15-34). The Examiner has noted that the exchange of Walker can keep the experts availability standards. (Walker, col. 14, lines 27-28). However, given the nature of the exchange itself, namely that requests are sent, and then bids are collected, it is apparent that the availability standard noted by the Examiner cannot be real-time availability as required by claim 1. The plain language of Walker, including that cited by Examiner, makes clear that there is a necessary time delay in the retrieval or exchange of information between the expert and user.

In the Advisory Action dated March 24, 2005, Examiner asserts that Walker discloses the attribute of real time availability, and further discloses an expert database that maintains data on the expert, including availability standards. Examiner points to Walker (at col. 3, lines 32-59) as disclosing the attribute of real time availability. However, Appellant respectfully points out that Examiner is remiss in his contention. After all, Walker only contemplates the option of an expert locating a potential client in the future (distant or near). Walker mentions an expert being able to locate a potential client on "short notice" (see col. 3, lines 55-57), but does not contemplate a user having access to the expert's availability in real-time. At best, Walker provides the ability for an expert to look for work from a user, where the expert can respond on short notice. Put simply, Walker wholly fails to suggest maintaining and updateable and searchable database of expert profiles wherein one of the attributes is the expert's real time availability. Examiner also points to Walker (at col. 14, lines 27-28) as disclosing the maintenance of expert availability standards. Again, however, Examiner misses that Walker requires that first requests are sent, and then bids are collected. As such, the availability standard noted by Examiner is not real-time availability as required by claim 1. In view of the above, Walker or any suggested combination thereof, fails to disclose every limitation of Appellant's claimed invention. As such, claim 1 and claims depending therefrom (claims 2, 4-16), are not anticipated by any presently suggested combination relying on Walker.

Chao is not relied upon by the Examiner as teaching availability. It is clear from Chao that the availability of the instructor is not kept because Chao attempts to establish a session which may fail because the instructor or student is not available. (Chao, col. 5, line 66 through col. 6, line 4). If real-time availability were kept as an attribute, Chao would not attempt to establish a session if it knew the instructor was not available.

Neither Walker or Chao disclose maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability, the combination of references do not teach all of the claimed limitations. Therefore, Appellant respectfully asserts that claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 5, 7, 8, 15, and 16 depend from claim 1 and are therefore allowable for at least the reasons set forth above with respect to claim 1. Specifically, claims 5, 7, 8, 15, and 16 each require, through their dependencies from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. Again, the combination of Walker and Chao fails to teach these limitations. Therefore, Appellant respectfully asserts that claims 5, 7, 8, 15, and 16 are allowable for at least the reasons set forth above.

B. Claims 4, 6, and 9

Claims 4, 6, and 9 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,862,223 to Walker et al. (hereinafter "Walker") in view of U.S. Patent Number 6,325,632 to Chao et al. (hereinafter "Chao").

Claims 4, 6, and 9 depend from claim 1 and are therefore allowable for at least the reasons set forth above with respect to claim 1. Specifically, claims 4, 6, and 9 each require, through their dependencies from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. Again, the combination of Walker and Chao fails to teach these limitations. Therefore, Appellant respectfully asserts that claims 4, 6, and 9 are allowable for at least the reasons set forth above. Moreover, for the reasons set forth below, claims 4, 6, and 9 include additional requirements not shown in Walker or Chao.

Claim 4 requires "the database automatically updates the expert's availability." The Examiner asserts that Walker teaches a method wherein the database automatically updates the expert's availability. However, Appellant respectfully points out that the Walker database does not automatically update the expert's availability. Rather, the status of an expert's availability is only changed once the expert manually logs-in to the Exchange and provides his expert ID. (Walker col. 8, lines 29-31). As such, availability status only changes when an expert decides to make such a change. Taken further, the database as taught in Walker is not an updateable and searchable database of expert profiles wherein one of the attributes is the expert's real time availability, rather the Walker database must be prompted by the expert himself. In so much, the Walker database is hardly automatic.

Claim 6 requires "the attribute is the expert's available time until a next assignment." The Examiner asserts that Walker teaches a method wherein the attribute is the expert's time until a next assignment. Appellant respectfully points out that Walker does not teach a method for maintaining the expert's available time until a next assignment. Walker does disclose a database for maintaining an expert's "availability standard;" however, this availability standard refers to availability status, which as mentioned before, can only be manually changed by an expert. (*See* Walker col. 8, lines 29-31). As such, the availability standard provided by the Walker database (i.e., "currently available" or "currently unavailable") is not an updateable and searchable database of expert profiles wherein one of the attributes is the expert's real time availability, but only refers to the availability status the expert has most recently designated.

Claim 9 requires "the attribute is the expert's travel speed." The Examiner asserts that Walker teaches a method wherein the attribute is the expert's travel speed. Appellant respectfully points out that Walker does not teach a method for maintaining the expert's travel speed; more specifically, Appellant cannot find, in Walker, any reference to expert's travel speed. Walker does disclose a database for maintaining an expert's "availability standard." Also, Chao is not relied upon as teaching this limitation. The availability standard discussed in Walker refers to availability status, which as mentioned before, can only be manually changed by an expert. (*See* Walker col. 8, lines 29-31). As such, the availability standard provided by the Walker database (i.e., "currently available" or "currently unavailable") is not an updateable and searchable database of expert profiles wherein one of

the attributes is the expert's real time availability, but only refers to the availability status the expert has most recently designated.

C. Claims 17, 20, and 21

Claims 17, 20, and 21 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao and further in view of U.S. Patent Number 5,544,049 to Henderson et al. (hereinafter "Henderson").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second or third criteria, Appellant asserts that the rejection does not satisfy the first criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

With respect to claims 17, 20, and 21, Examiner states that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Appellant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

As stated above, Walker describes an exchange service where requests from users solicit bids from competing instructors. (Walker col. 7, lines 6-34). Walker does not return a list of experts to the user which can be ranked, instead it submits the request and returns bids. There is no list to rank and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in

view of Chao and further in view of Henderson put forth by the Examiner, therefore, does not comport with the requirements of *In re Gordon* and is, therefore, improper.

In the Advisory Action dated March 24, 2005, Examiner asserts that there is motivation to combine Walker with other suggested references by virtue of the following language found in Walker: "A still further object of the present invention is to allow the client to choose from a list of experts in a field and select a particular expert to provide service, where such service is in the form of expert advice or judgment." Examiner's reasoning is flawed in so much as the cited language does not provide appropriate motivation to combine the suggested references. The scheme of Walker requires that first a work request be sent by a user, and then bids submitted in response by a group of experts. The list disclosed by Walker is produced by experts who have submitted their bid in response to a user request. (*See* Walker col. 8, lines 33-36). Alternatively, Walker (at col. 8, lines 49-54) allows a user to select a particular expert, or group of experts, from a larger list. Afterward, a work request is sent to selected experts, who then have then the option of bidding on the request. Certainly, there is no reason to rank the list of experts since the final group of responding experts, or those even having acceptable responses, is unknown. Finally, Walker (at col. 20, lines 64-65) discusses a user sending a message to a list of expert's produced from a World Wide Web search result. Again, to rank the list of potential candidates without knowing which experts will respond with acceptable bids, if at all, would be unproductive. Therefore, even in view of Examiner's most recent comments, there would be no motivation to rank or order the list of Walker as described by Henderson. Further, imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose. In view of the above, Examiner's reliance on the suggested combination(s) is inappropriate as there is no motivation to combine the suggested references. As such, claim 17 and claims depending therefrom (claims 18-24), are not anticipated by the suggested combination.

Claims 20 and 21 depend from claim 17 and are therefore allowable for at least the reasons set forth above with respect to claim 17. Specifically, the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose. Therefore, Appellant respectfully asserts that claims 20 and 21 are allowable for at least the reasons set forth above.

D. Claim 2

Claim 2 currently stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, and further in view of Henderson.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first or third criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As set forth above, the Examiner states that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Appellant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

As previously stated, Walker describes an exchange service where requests from users solicit bids from competing instructors. (Walker col. 7, lines 6-34). Walker does not return a list of experts to the user which can be ranked, instead it submits the request and returns bids. There is no list to rank and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view Chao in view of Henderson put forth by the Examiner, therefore, does not comport with the requirements of *In re Gordon* and is, therefore, improper.

Further, the combination cited by the Examiner lacks all of the limitations found in claim 2. Claim 2 depends from claim 1, and requires, through its dependency from claim 1,

maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. For the reasons set forth with respect to claim 1, neither Walker, Chao, nor Henderson describe at least these limitations. Appellant, therefore, respectfully asserts that claim 2 is allowable, for at least the reasons set forth, over the 35. U.S.C. §103 rejection.

E. Claim 10

Claim 10 currently stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of keen.com.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first or third criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As mentioned above, Examiner states that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Again, for the reasons mentioned above, Appellant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose. That is, Walker does not return a list of experts to the user which can be ranked, instead it submits the request and returns bids. There is no list to rank and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose.

Further, the Examiner states that it would have been obvious to combine the teachings of Walker with the teachings of keen.com to provide the ability to automatically connect a user to a selected Expert. The motivation being that it would be the quickest method of establishing a connection between the user and expert, thus expediting the process. The Examiner is again overlooking that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, or connected immediately as in keen.com, instead it submits the request and returns bids. There is no list to rank and no listed names to automatically connect. Imposing the ranked list of Henderson and/or the "call now" feature of keen.com on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao in view of Henderson and further in view of keen.com put forth by the Examiner, therefore, does not comport with the requirements of *In re Gordon* and is, therefore, improper.

Further, the combination cited by the Examiner lacks all of the limitations found in claim 10. Claim 10 depends from claim 1, and requires, through its dependency from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. The Examiner has cited keen.com web pages in the rejection of claim 10 as teaching a method wherein the user is automatically connected to a selected expert using a "Call Now" icon on the list of experts. The "Call Now" icon does not indicate that the expert would be available at that moment, and it appears to be always part of the list which would indicate that the expert may be available or the user may have to leave a message. It is apparent, therefore, that the keen.com website does not keep the real-time availability of the expert as required by claim 1, but merely has a one-click method to contact the expert. In the Advisory Action dated March 24, 2005, Examiner asserts that the "Call Now" icon of the keen.com reference teaches that a user is automatically connected to a selected expert. In support of such assertion, Examiner characterizes Appellant's claim 1 as "merely that the system maintain information regarding the expert's real-time availability." However, this characterization is not accurate. Appellant's claim 1 requires "maintaining an updateable and searchable database of expert profiles... wherein one of the attributes is the expert's real-time availability." Examiner, by way of mischaracterization, incorrectly limits the scope of Appellant's claimed invention. For the reasons set forth above and with respect to claim 1, neither Walker, Chao, Henderson, nor the web pages of keen.com describe at least

these limitations. Appellant, therefore, respectfully asserts that claim 10 is allowable, for at least the reasons set forth, over the 35. U.S.C. §103 rejection.

F. Claims 11-14

Claim 11-14 currently stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of U.S. Patent Number 6,223,165 to Lauffer (hereinafter "Lauffer").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first or third criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Examiner states that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Appellant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose.

As before, the Examiner overlooks that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, instead it submits the request and returns bids. There is no list to rank, and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao in view of Henderson and further in view of Luaffer

put forth by the Examiner, therefore, does not comport with the requirements of *In re Gordon* and is, therefore, improper.

Further, the combination cited by the Examiner lacks all of the limitations found in claims 11-14. Claims 11-14 depend from claim 1, and requires, through their dependencies from claim 1, maintaining ... attributes of a particular expert, ... wherein one of the attributes is the expert's real-time availability. For the reasons set forth with respect to claim 1, neither Walker, Chao, Henderson, nor Lauffer describe at least these limitations. Appellant, therefore, respectfully asserts that claims 11-14 are allowable, for at least the reasons set forth, over the 35. U.S.C. §103 rejection.

G. Claims 18, 19, 22, and 23

Claims 18, 19, 22 and 23 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao, in view of Henderson and further in view of U.S. Patent Number 6,370,231 to Hice (hereinafter "Hice").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second or third criteria, Appellant asserts that the rejection does not satisfy the first criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Examiner states that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Appellant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its

intended purpose. That is, Walker does not return a list of experts to the user which can be ranked, instead it submits the request and returns bids. There is no list to rank and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose.

Further, the Examiner states that it would have been obvious to combine the teachings of Walker with the teachings of Hice to incorporate the task management system of Hice with the expert identification system. The motivation being that it would allow clients to receive timely information on the status of a given expert and the expert's availability. The Examiner is again overlooking that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, or track the status of a given expert or the expert's availability, instead it submits the request and returns bids. There is no list to rank and no mechanism for tracking expert status or availability in the request/bid process. Imposing the ranked list of Henderson and/or the task management system of Hice on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao, in view of Henderson and further in view of Hice put forth by the Examiner, therefore, does not comport with the requirements of *In re Gordon* and is, therefore, improper.

H. Claim 24

Claim 24 currently stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Chao in view of Henderson in view of Hice and further in view of U.S. Patent Number 5,570,100 to Grube et al. (hereinafter "Grube").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second or third criteria, Appellant asserts that the rejection does not satisfy the first criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As stated, the Examiner stated that it would have been obvious to combine the teachings of Walker with the teachings of Henderson to obtain a ranked list of search results to the user. The motivation being to ease the burden on the user to peruse a possibly extensive list of matching results. Appellant respectfully asserts that the teaching of Henderson and the teaching of Walker are not combinable without rendering Walker unsatisfactory for its intended purpose. That is, Walker does not return a list of experts to the user which can be ranked, instead it submits the request and returns bids. There is no list to rank and imposing the ranked list of Henderson on the exchange of Walker would render Walker unsatisfactory for its intended purpose.

Further, the Examiner has stated that it would have been obvious to combine the teachings of Walker with the teachings of Hice to incorporate the task management system of Hice with the expert identification system. The motivation being that it would allow clients to receive timely information on the status of a given expert and the expert's availability. The Examiner is again overlooking that Walker is an on-line exchange which receives requests and submits them for bids. In such a bid request paradigm, Walker does not return a list of experts to the user which can be ranked as in Henderson, or track the status of a given expert or the expert's availability, instead it submits the request and returns bids. There is no list to rank and no mechanism for tracking expert status or availability in the request/bid process. Imposing the ranked list of Henderson and/or the task management system of Hice on the exchange of Walker would render Walker unsatisfactory for its intended purpose. The combination of Walker in view of Chao in view of Henderson in view of Hice and further in view of Grube put forth by the Examiner, therefore, does not comport with the requirements of *In re Gordon* and is, therefore, improper.

## VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Appellant on March 4, 2005.

## IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

## X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

The fee for the Appeal Brief is noted on the Transmittal Sheet. Additionally, at any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account No. 08-2025. under Order No. 10004546-1, from which the undersigned is authorized to draw.

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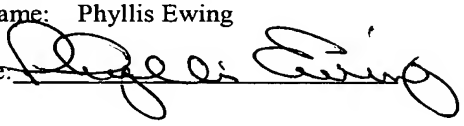
Signature: 

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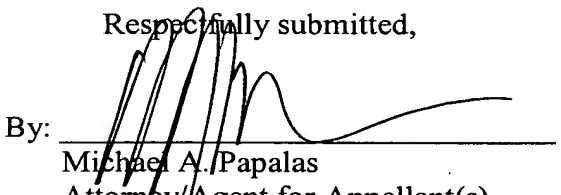
By: 

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## APPENDIX A

**Claims Involved in the Appeal of Application Serial No.** 10/056,592

1. A method of identifying relevant experts using a search request from a user, comprising:

maintaining an updateable and searchable database of expert profiles, wherein the profiles include attributes of a particular expert, and wherein one of the attributes is the expert's real-time availability;

receiving a search request from the user; and

applying a weight designated by the user to the attributes of a desired expert.

2. The method of claim 1 further comprising:

searching the database using the search request; and

displaying a list of ranked experts, wherein each expert's position in the ranked list is determined by a ranking algorithm wherein said ranking algorithm uses the weights of each attribute and is based on both static attributes and dynamic attributes.

4. The method of claim 1 wherein the database automatically updates the expert's availability.

5. The method of claim 1 wherein the attribute is the expert's area of knowledge.

6. The method of claim 1 wherein the attribute is the expert's available time until a next assignment.

7. The method of claim 1 wherein the attribute is the expert's proximity to the user.

8. The method of claim 1 wherein the attribute is the expert's available contact method.

9. The method of claim 1 wherein the attribute is the expert's travel speed.

10. The method of claim 2 wherein the user is automatically connected to a selected expert by interfacing with the expert's name as it appears on the displayed list.

11. The method of claim 2 wherein a menu appears with available contact mediums when an expert is selected.

12. The method of claim 11 wherein the contact medium is email and when selected a dialog box appears for the user to prepare and send an email to the expert.

13. The method of claim 11 wherein the contact medium is telephone and when selected the expert's telephone number is displayed.

14. The method of claim 1 further comprising:

selecting a messaging communication mode by which the user contacts a selected expert.

15. The method of claim 1 wherein the profile is able to be created by the expert.

16. The method of claim 1 wherein the profile is able to be updated by the expert.

17. A system for searching for experts, comprising:

a searchable and updateable database of expert information, wherein said database comprises a plurality of expert profiles, each of said profiles including data relating to one or more static and dynamic attributes of a particular expert;

a user interface for allowing users to identify desired characteristics of a desired expert, wherein the user interface also allows users to assign weights to one or more of the desired characteristics;

a processor for:

searching said database using said desired characteristics, and

generating a list of ranked experts; and

a display for displaying said ranked list, wherein each expert's position in the list is determined by a ranking algorithm based on said static attributes and said dynamic attributes.

18. The system of claim 17 further comprising:

a work order system for processing and storing data related to an expert's work assignments wherein said work order system communicates said work assignment data with said searchable and updateable database.

19. The system of claim 18 wherein said work assignment data comprises one or more of:

data related to an estimated time of arrival of an expert; and

data related to an estimated completion time for an expert to complete a work assignment.

20. The system of claim 17 wherein said ranking algorithm further ranks said list of experts according to:

a correlation between each expert's expert profile and the user's desired expert characteristics; and

said-weights that the user has assigned to certain characteristics.

21. The system of claim 17 wherein a user interfaces with the database via a remote wireless or wireline Internet connection.

22. The system of claim 18 further comprising:

a location tracking information system for generating data related to the expert's location wherein said work order system communicates said location data with said searchable and updateable database.

23. The system of claim 22 wherein said location data comprises one or more of:

data that defines a user's location in relation to an expert's location; and

data that defines an expert's fixed location.

24. The system of claim 23 wherein said location tracking information system is a Global Positioning System (GPS).